

Applicant: Lars Severinsson
Filed: November 10, 2000
Page 4

Remarks

In an Office Action mailed on February 15, 2000 during prosecution of the parent to the present application, Examiner Chris Schwartz rejected amended claim 16 of the parent application, which is identical to claim 25 above, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,433,298 to Antony et al. Applicant filed a Response on April 12, 2000, requesting that the Examiner reconsider his position and highlighting the novel aspects of the invention over the cited prior art. Thereafter, Examiner Schwartz telephoned Applicant's attorney, Todd Oberdick, to inform him that although Examiner Schwartz had determined that Claim 16 was patentable over the references of record, and had attempted to issue a Notice of Allowability, a reissue supervisor at the U.S. Patent Office had instructed Examiner Schwartz not to issue the Notice of Allowability, and instead reject Claim 16 under the theory of impermissible recapture. In response to this telephone conversation, Applicant amended Claim 16 to remove any question of recapture so as not to delay the issuance of the parent application. Applicant now files the present application, with the above Claim 25 being identical to Claim 16 of the parent case before having been amended to remove any question of recapture.

For the foregoing reasons, Applicant respectfully submits that any questions of patentability with respect to the prior art have already been resolved, and that the only issue presented in this case relate to the recapture allegation.

During the telephone call described above, the Examiner objected to Claim 16 (now Claim 25 of the present application) on the grounds that it had been amended in a manner which resulted in the impermissible recapture of surrendered subject matter. More specifically, the claim had been amended so as to not require cover (2). Applicant respectfully disagrees that recapture exists.

It is well known that a reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. However, Applicant respectfully submits that such is not occurring here.

In the parent application, there were two sets of claims. Claims 1-12 were directed to a modular disc brake system having a housing (1), a cover (2), and a plurality of other components carried by the cover (2) independently of the housing. Claim 13, which was added later during prosecution, was directed to a disc brake system having a particular wedge configuration. Unfortunately, Claim 13 also recited a cover (2) in addition to a housing (1).

Therefore, the two sets of claims related to two completely different points of novelty: the first set of claims (Claims 1-12) related to the modular configuration, while the second set of claims (Claim 13) related to the wedge configuration. Moreover, while the cover (2) was required for the first set of claims, and arguments were made to this effect during prosecution of the parent application, the cover (2) was not required for patentability for the second set of claims, and no arguments were made for patentability of Claim 13 based upon the presence of the cover (2). The inclusion of the cover (2) in Claim 13 was erroneous, and in fact constitutes one of the bases for the reissue application (See Second Supplemental Reissue Declaration Of Lars Severinsson, Para. 5).

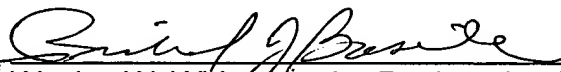
Applicant is now attempting to remedy the erroneous inclusion of the cover (2) in the claims relating to the wedge configuration. This is not recapture, as no argument was made during prosecution of the parent that the cover (2) was necessary for patentability of the claims directed to the wedge configuration. The only arguments which were made regarding the cover (2) concerned the claims directed to the modular configuration. As such, Applicant never surrendered a claim directed to the wedge configuration without a cover (2), and there can be no recapture of such a claim. It is now, and has always been, Applicant's position

Applicant: Lars Severinsson
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Page 7

that the wedge configuration alone is patentable over the prior art regardless of whether or not the system includes a cover (2), and the Examiner apparently agreed by his indication that a Notice of Allowance would have issued absent the issue of recapture.

For the foregoing reasons, Applicant respectfully submits that Claims 25-28 are patentable over the references of record and earnestly solicits allowance of the same.

Respectfully submitted,



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